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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,005	01/20/2004	Ehud Cohen	U 014996-9	1642

140 7590 04/23/2007  
LADAS & PARRY  
26 WEST 61ST STREET  
NEW YORK, NY 10023

EXAMINER
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NATNITHADHA, NAVIN

ART UNIT	PAPER NUMBER
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3735

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/761,005	COHEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Navin Natnithithadha	3735	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 277-301 and 316 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 277, 279-301 and 316 is/are rejected.
- 7) ☒ Claim(s) 277 and 278 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 February 2007 has been entered.

### ***Response to Amendment***

2. Claims 277-279, 285, 286, and 290 have been amended. Claims 1-276 and 302-315 have been cancelled. Claims 316 have been added. Claims 277-301 and 316 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 277-301 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Objections***

4. Claim 287 is objected to because of the following informalities:

The limitation “wherein the circuitry is adapted to be implanted in the patient” does not further limit claim 277, for which claim 287 is dependent on, since claim 277 states “implantable circuitry, having medical functionality, which is adapted to be placed in the patient”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 277, 287, 288, 291-301, and 316 are rejected under 35 U.S.C. 102(b) as being anticipated by Conrad, US 2,816,997 A (“Conrad”).

Claims 277, 287, 288, and 291: The critical part of Applicant’s invention appears to be the structural arrangement of an “implantable circuitry”, “a lead wire”, and “an electrically-conductive hollow tube”.

Conrad teaches a medical apparatus for placement in a patient (see fig. 4), comprising: implantable circuitry (thermistor) 8, having medical functionality, which is adapted to be placed implanted in the patient and incorporated in a catheter (“suitable for incorporation in hypodermic needles or catheters for use in measuring local temperatures in the human or other animal bodies”, see col. 1, ll. 15-19), and is a

Art Unit: 3735

temperature sensor; a lead wire 76; and a hollow tube 80 soldered (at 78) directly to the circuitry 8 and coupled to the lead wire 76 so as to be electrically coupled thereto.

Claims 292-301: These claims appear to be alternative species of the “implantable circuitry” that are not critical to Applicant’s invention. Since Conrad teaches a temperature sensor (thermistor) 8, Conrad teaches one of the species claim 295 and the generic claims 291 and 297 (sensor can be considered an active element for “actively” sensing a parameters, such as temperature).

Claims 316: This claim contains subject matter regarding a process for manufacturing the apparatus of claim 277 and does not further limit the structural elements of claim 277. Thus, Conrad anticipates the structural limitations of claim 316.

6. Claim 277, 291-301, and 316 are rejected under 35 U.S.C. 102(b) as being anticipated by Weinand, US 5,037,488 A (“Wienand”).

Claims 277 and 291: Weinand teaches an apparatus (see fig. 2), comprising: circuitry (thermo-sensor) 11, which is capable of being implanted in a patient (matter of intended use and not structurally different); a lead wire 12/13; and an electrically-conductive hollow tube 1, which is soldered directly to the circuitry 8, and coupled to the lead wire 12/13.

Claims 292-301: These claims are alternative species of the “implantable circuitry” that are not critical to Applicant’s invention. Since Wienand teaches a temperature sensor (thermo-sensor) 11, Wienand teaches one of the species claim 295 and the

Art Unit: 3735

generic claims 291 and 297 (sensor can be considered an active element for “actively” sensing a parameters, such as temperature).

Claims 316: This claim contains subject matter regarding a process for manufacturing the apparatus of claim 277 and does not further limit the structural elements of claim 277. Thus, Conrad anticipates the structural limitations of claim 316.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 280-285, 289, and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad, or in the alternative Weinand, as applied to claim 277 above, and further in view of Skubitz et al, US 5,851,226 A (“Skubitz”).

Claims 280-285, 289, and 290: Neither Conrad nor Weinand explicitly teach the lead wire 274 comprises MP35N, platinum/iridium, alloys having low iron content (i.e. 1-60%, 1-40%, or 1-20% iron by weight), or silver and the connector is coated with gold or comprises steel. However, Skubitz teaches “outer conductor 55 may optionally comprise wires formed of a nickel-titanium alloy such as NITINOL.TM. [i.e. MP35N] , platinum, gold, silver, palladium, other noble metals, and other alloys [i.e. steel] or metals suitable for use in the human body. NITINOL.TM. may be purchased from Fort Wayne Metals of Fort Wayne, Ind.” (see col. 16, ll. 51-62). In fact, Applicant’s disclosure, on page 7, lines 27-32, admits that “these materials have proven to be both safe and effective for many applications in the human body”. Therefore, it would have

Art Unit: 3735

been obvious for one of ordinary skill in the art at the time the invention was made to modify Conrad's lead wire 76 (or Weinand's lead wire 12) and hollow tube 80 to comprise the materials of claims 280-284 and 289 because these materials are well known in the art to be suitable materials for use in the human body, as stated by Skubitz (see col. 16, ll. 51-62).

8. Claim 286 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad, or in the alternative Weinand, as applied to claims 277 above, and further in view of Delfino et al, US 6,129,658 A ("Delfino").

Claim 286: Neither Conrad nor Weinand teach that the hollow tube 76 has been treated with phosphoric acid. However, Delfino teaches using phosphoric acid solutions for treating implantable medical apparatuses (see col. 2, ll. 35-36). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to treat Conrad's hollow tube 76 (or Weinand's hollow tube 1) with phosphoric acid because Delfino discloses that "Metal-phosphate coating processes using phosphoric acid solutions are also known for depositing coatings of to prevent corrosion, lubricate, prolong the life of metal surfaces, and improve paint coating adhesion" (see col. 2, ll. 35-36).

***Allowable Subject Matter***

9. Claims 278 and 279 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Claims 278 and 279: The prior art of record does not teach a medical apparatus of claim 277, including: a hollow tube that is crimped to the lead wire, so as to be mechanically coupled thereto, and a portion of the lead wire is disposed within the hollow tube, and wherein the hollow tube is crimped to the portion of the lead wire.

***Conclusion***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3735

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Navin Natnithithadha  
Patent Examiner  
Art Unit 3735

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04/23/2007